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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,801	04/04/2001	Staffan Folestad	1103326-0659	6014
7470	7590	08/16/2006	EXAMINER WEST, PAUL M	
WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036			ART UNIT 2856	PAPER NUMBER

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/806,801

Applicant(s)

FOLESTAD ET AL.

Examiner

Paul M. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 12-15, 17-21 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 3, 8-11, 16, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,6,7,12,17-21,26,27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al in view of Soloman.
3. Regarding claims 1,2 and 27, Wong et al. teach an apparatus for use in analyzing pharmaceutical samples, comprising: means for temporarily fixing the sample in an analyzing position, where in the fixing means comprises a first and second holding part 1, wherein the holding parts each define an aperture 2a,2b and together define an effective optical aperture 2 in the closed position, and wherein the holding parts 1 open at the analyzing position to receive the sample and close on opposite sides of the sample at the analyzing position for analysis. Wong et al. does not explicitly describe a feeding means. Soloman teaches an apparatus for optically analyzing tablets in which a rotating feeder wheel feeding means 14,15 comprises a pre-alignment means 15 for receiving and holding a sample during transport to an analyzing position in receptacle 4. It would have been obvious to one of ordinary skill in the art to have an automated feed means as taught by Soloman to transport samples to the analyzing position, because this would allow for more efficient and uniform testing procedures which decreases

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error. Also it decreases handling of samples by operators which decreases opportunity for contamination.

4. Regarding claim 6, Wong et al. teach the first and second holding parts 1 each defining a first and second compartment which together define a predetermined volume (Col. 9, lines 42-58).

5. Regarding claim 17, Wong et al. teach the sample being a solid dosage form (Col. 8, line 66).

6. Regarding claims 18 and 28, Wong et al. teach a method of presenting the sample, comprising: feeding the sample to the holding parts 1 which are open at the analyzing position (Col. 4, lines 48-49); and fixing the sample at the analyzing position by closing the first and second holding parts (Col. 4, lines 60-61). Wong et al. do not specifically mention opening the holding parts to allow the sample to be removed, however they do teach that the holding parts are releasably clamped (Col. 9, lines 15-17). Therefore it would have been obvious to one of ordinary skill in the art to open the holding parts in order to remove the sample from the analyzing position to an ejecting position because this is the only way to allow for the method to be repeated with another sample to be analyzed.

7. Regarding claims 19-21, Wong et al. teach making an optical measurement by irradiating the sample with a measuring radiation beam of near-infrared light while the sample is being fixed in the analyzing position (Col. 5, lines 16-18).

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8. Regarding claims 7 and 12, Wong et al. teach all of the limitations as set forth above but do not teach a feeding means which comprises a pre-alignment means for receiving and holding a sample during transport to the analyzing position. Soloman teaches an apparatus for optically analyzing tablets in which a rotating feeder wheel feeding means 14,15 comprises a pre-alignment means 15 for receiving and holding a sample during transport to an analyzing position in receptacle 4. It would have been obvious to combine the feeding means of Soloman with the apparatus of Wong et al. because it would provide an efficient and automated way to move solid samples in sequence to the analyzing device.

9. Regarding claim 26, Wong et al. do not teach the solid sample being a tablet, however Soloman teach an optical measuring device for measuring solid tablet samples. It would have been obvious to one of ordinary skill in the art to use Wong's apparatus to analyze solid tablets such as pharmaceutical tablets and pills because analysis is necessary in this field to maintain high quality control.

10. Claims 13-15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong et al. in view of Soloman and further in view of Schilling.

11. Regarding claims 13-15, the combination of Wong et al. and Soloman teaches the limitations as set forth above but does not teach a sample receiver which provides a feeder wheel with samples. Schilling teaches an online sample receiver 1 which provides a feeder wheel with samples. It would have been obvious to one of ordinary skill in the art to combine the teachings of Schilling with the combination of Wong and

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Soloman because using a sample receiver would ensure that a constant supply of tablets to be tested are always available. It would have been further obvious to use the sample receiver as an at-line sample receiver depending on the application and particular equipment setup, because this would make it less expensive to setup and more portable.

12. Regarding claim 25, the combination of Wong, Soloman, and Schilling does not teach the sample receiver being connected to an instrument which makes tablets, however, it would have been obvious to one of ordinary skill in the art to do this because it is common and well-known to test and analyze products during the manufacturing process in order to increase efficiency and reduce manufacturing costs.

### ***Allowable Subject Matter***

13. Claims 3,8-11,16,22 and 23 are objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

14. Applicant's arguments filed 14 June 2006 have been fully considered but they are not persuasive.

15. Applicant has argued that because the Wong reference teaches using disposable single use analyzing holders, an automated feed means would not be useful or would

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somehow detract from the purpose of the invention. However, Wong et al. specifically teach making the holders disposable in order to decrease contamination and/or eliminate the need to clean the sample holders. Automating the process of feeding the sample to the holder would not detract from this inventive feature and would further decrease the possibility of contamination by eliminating the need for a human operator to handle the samples before they are analyzed.

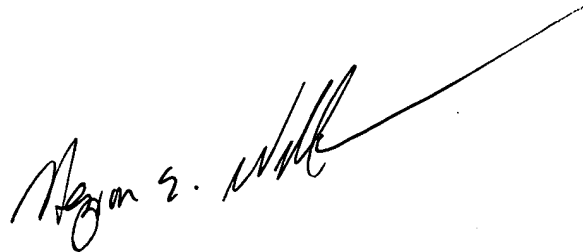
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul M. West whose telephone number is (571) 272-8590. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Hezron Williams", with a long, sweeping horizontal line extending to the right.

HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800